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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,532	12/03/2003	Paul Martyn Kanc	14723.0001	3210
7590 D. Douglas Price Steptoe & Johnson LLP 1330 Connecticut Avenue, N.W. Washington, DC 20036			EXAMINER AVELLINO, JOSEPH E	
			ART UNIT	PAPER NUMBER
			2143	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/18/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

# Office Action Summary

Application No.

10/725,532

Applicant(s)

KANE ET AL.

Examiner

Joseph E. Avellino

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/3/03, 7/24/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-10 are presented for examination; claims 1, 3, 5, and 10 independent.

The Office acknowledges the preliminary amendment canceling claims 11 and 12.

### ***Priority***

2. The Office acknowledges Applicant's claim of priority under 35 USC 119.

### ***Information Disclosure Statement***

3. The IDS's submitted December 3, 2003 and July 24, 2006 have been considered. See enclosed PTO-1449.

### ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 2 are rejected under 35 U.S.C. 101 because they are not statutory.

5. Referring to claim 1, A claim which falls within a judicial exception may be statutory only if it provides a "useful, concrete and tangible result." State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02. As such, the claim above provides multiple embodiments which may be interpreted. One such interpretation is that if no matching name is detected, sending a referral response to the answer of the request; however, another interpretation is that a matching name is detected, and therefore no referral

response is sent. As such, the result of the claim merely compares the request with a database of names to detect any matching names in the database, which is not a useful or tangible result. The comparison done is not provided in a format which may be useful to anything. As such, claim 1 does not satisfy the useful, concrete, and tangible result test and therefor is not statutory.

6. Claim 2 is rejected for similar reasons as stated above.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Applicants Admitted Prior Art (Background to the Invention, pages 1-4) (hereinafter AAPA).

8. Referring to claim 1, AAPA discloses a method of resolving an address request in a computer system (i.e. DNS system) comprising the steps of:

receiving a name (i.e. questions) at a first server with a request for an address corresponding to that name (i.e. "the answer may contain several records") (pp. 1-2);

comparing the name with a database of names to detect any matching name in the database (i.e. an inherent feature of DNS is that in order to return answers to questions, the system must search the database for a match to the requested domain name) (pp. 1-2); and

if no matching name is found, sending a referral response answer to the request (i.e. "referrals are returned to a client where a DNS server must return the name of another DNS server which is able to properly answer the client's question") (p. 2).

9. Referring to claim 2, AAPA discloses the first server is a first DNS server and the second server is a second DNS server (i.e. "return the name of *another* DNS server" implying a second DNS server is within the system) (p. 2).

10. Claims 3 and 4 are rejected for similar reasons as stated above.

11. Referring to claim 5, AAPA discloses the invention as described above. AAPA furthermore discloses returning a synthesized address response to the user (i.e. direct answer) (p. 2).

12. Referring to claim 6, AAPA discloses determining the type of request (i.e. "query type allows the client to choose which type of information they require") (p. 2).

13. Claim 10 is rejected for similar reasons as stated above.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Mockapetrtis ("Domain Names – Implementation and Specification"; RFC 1035; November 1987) (cited by Applicant in IDS) (hereinafter RFC).

15. Referring to claim 7, AAPA discloses the invention substantively as described in claim 5. AAPA does not explicitly state the use of determining whether a start of a request matches a known string of characters. IN analogous art, RFC discloses the DNS specification which compares labels (from the request versus the database) (section 3.1: "name servers...must compare labels in a case-insensitive manner...non-alphabetic codes must match exactly"). It would have been obvious to one of ordinary skill in the art to combine AAPA with RFC since it further discusses the implementation of DNS, which is briefly discussed. RFC would give one of ordinary skill in the art a further detailed implementation.

16. Referring to claim 8, AAPA discloses the invention substantively as described in claim 5. AAPA does not specifically disclose that the request is an address resolution request, however it does state requesting records (p. 2). In analogous art, RFC discloses DNS receives a standard query resolving a domain name to an IP address (i.e. host address) (section 1, and section 3.4.2, "a 32 bit Internet address...an 8 bit IP protocol number). It would have been obvious to one of ordinary skill in the art to combine AAPA with RFC since it further discusses the implementation of DNS, which is briefly discussed. RFC would give one of ordinary skill in the art a further detailed implementation.

17. Claim 9 is rejected for similar reasons as stated above.

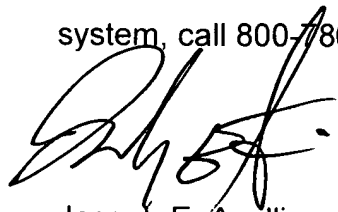
### ***Conclusion***

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph E. Avellino whose telephone number is (571) 272-3905. The examiner can normally be reached on Monday-Friday 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Joseph E. Avellino, Examiner  
March 12, 2007